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EXAMINER

WINDER, P

ART UNIT

PAPER NUMBER

2758

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/060,867

Applicant(s)

Busey et al.

Examiner
Patrice L. Winder

Group Art Unit
2758



☒ Responsive to communication(s) filed on May 10, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-70 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-70 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2758

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-70 are rejected under the judicially created doctrine of double patenting over claims 1-2, 4-5 of U. S. Patent No. 5,794,916 since the claims, if allowed, would improperly extend the "right to exclude" already granted by claims 1-2, 4-5 in the patent, and may result in possible harassment by multiple assignees.

The claimed invention in the instant application is fully disclosed in the patent and is ***broader*** than the claimed invention in the patent. No new invention, or new improvement is being claimed in the instant application. Applicant is now attempting ***to claim broadly that which had been previously described in more detail in the claims of the patent (In re Van Ornum, 214 USPQ 761 CCPA 1982).***

Art Unit: 2758

Claim^s 1, 14, 29, 39, 46, 56, in the instant application simply *omits* launching a real time chat server; launching first and second real time chat clients; and wherein the communications connection between the first real time chat client and the chat server and between the second real time chat client and the chat server of the previously patented claim 2; and

Claim^s 5, 10, 22, 33, 50, 64 in the instant application simply *omits* launching a real time chat server; launching first and second real time chat clients; and wherein the communications connection between the first real time chat client and the chat server and between the second real time chat client and the chat server of the previously patented claim 4.

Claims 1-4, 14, 17, 20-21, 29-30, 46-49, 56-58, 60-63, and 67-70 are rejected as obvious variations of claim 1 of U.S. Patent No. 5,764,916. Claims 15-16 and 18-19 are rejected as obvious variations of claim 2 of U.S. Patent No. 5,764,916. Claims 5-6, 8-10, 12-13, 22-23, 25-26, 33-36, 38-42, 44-45, 50-52, 54-55 and 64-65 are rejected as obvious variations of claim 4 of U.S. Patent No. 5,764,916. Claims 7, 11, 17, 24, 37, 43, 53, 59 and 66 are rejected on the same rationale as claim 5 of U.S. Patent No. 5,764,916.

For any given claim the obvious variation could be one or more of the following:

Substituting a markup language instruction or html instruction for the hyperlink instruction of U.S. Patent No. 5,764,916 would have been obvious because a hyperlink instruction is a well known markup language instruction or html instruction;

Art Unit: 2758

Substituting a bold tag or an italics tag for a markup language instruction of U.S. Patent No. 5,764,916 would have been obvious because each are hypertext markup language instructions, which is a well known type of markup language instruction;

Incorporating a computer to perform the method of U.S. Patent No. 5,764,916 would have been obvious because computers are well known apparatuses for performing data processing methods;

Incorporating a computer program product and application on an apparatus to perform the method of U.S. Patent No. 5,764,916 would have been obvious because computers are well known apparatuses which implement data processing methods by executing a computer program product and application;

Designating a first message and a second message for the message exchange of U.S. Patent No. 5,764,916 would have been obvious because a message exchange is a well known system where a first message is followed by a second message;

Substituting TCP/IP connections for the network connections of U.S. Patent No. 5,764,916 would have been obvious because TCP/IP is a well known protocol suite used for communications between hosts connected across the Internet;

Substituting a URL for the document address of U.S. Patent No. 5,764,916 would have been obvious because a URL is a well known document address for the web-based documents, such as web pages;

Art Unit: 2758

Substituting a real time continuously open bi-directional communications protocol connection for the real time communications protocol connection of U.S. Patent No. 5,764,916 would have been obvious because a continuously open bi-directional channel would have guaranteed the real time, conversational feature of the message exchange; and

Substituting a real time chat communications protocol connection for the real time communications protocol connection of U.S. Patent No. 5,764,916 would have been obvious because would have increased effectiveness of the message exchange by ensuring a conversational feel to the message exchange by using a real time chat protocol, such as IRC.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 14-16, 18-21, 29-32, 46-49 and 56-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. Patent No. 5,862,223 (hereafter referred to as

Art Unit: 2758

Walker) in view of WebBoard builds powerful on-line forum effortlessly (hereafter referred to as WebBoard).

5. As to claim 1, Walker taught a method for real time network communication (a method for real time synchronous communications), comprising:

forming a real time communications protocol connection over a network communications connections (forming a synchronous communication channel for real time text messaging over the network connections, col. 26, lines 45-46);

embedding text in a message (col. 26, lines 64-66); and

sending the message on the communications protocol connection (end user sends a message to expert over the synchronous communication channel, col. 26, lines 58-61).

Walker does not specifically teach wherein the text is a markup language instruction. However, WebBoard taught wherein embedded text is a markup language instruction (html tags, paragraph 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating WebBoard's embedded markup language instruction in Walker's message would have enhanced Walker's traditional message exchange by providing more browser-like features to the messages (WebBoard, paragraph 5). The motivation would have been to increase the effectiveness of the message exchange.

6. As to dependent claim 2, Walker does not specifically teach a hyperlink instruction. However, WebBoard taught wherein the markup language instruction is a hyperlink instruction (links to other sites, paragraph 5). For motivation for combination see claim 1, above.

Art Unit: 2758

7. As to dependent claim 3, Walker taught wherein the forming comprises forming a real time continuously open bi-directional communications protocol connection (opening a synchronous communication channel which is used to exchange messages between user, col. 27, lines 16-19); and

the sending comprises sending the message on the real time continuously open bi-directional communications protocol connection (sending message in real time across synchronous communication channel, col. 26, lines 39-44).

8. As to dependent claim 4, Walker taught the forming comprises forming a real time chat communications protocol connection (opening a synchronous communication channel to be used for real time text messaging, col. 27, lines 16-19); and

the sending comprises sending the message on the real time chat communications protocol connection (sending a real time text message, col. 26, lines 39-44).

9. Claim 14 is rejected on the same rationale as previously rejected claim 1.

10. As to dependent claim 15, Walker does not specifically wherein the markup language instruction is a html instruction. However, WebBoard taught wherein the markup language instruction is a html instruction (html tags, paragraph 5). For motivation for combination please see claim 1, above.

11. As to dependent claim 16, Walker does not specifically teach wherein the html instruction is a hyperlink instruction. However, WebBoard taught wherein the html instruction is a hyperlink

Art Unit: 2758

instruction (links to other Web sites, paragraph 5). For motivation for combination please see claim 1, above.

12. As to dependent claim 18, Walker does not specifically teach wherein the html instruction is a bold tag. However, WebBoard taught an html instruction (html tag, paragraph 5). For motivation for combination see claim 1, above. "Official notice" is taken that a bold tag is a well known html instruction. Therefore, a bold tag would have been an equivalent substitution.

13. As to dependent claim 19, Walker does not specifically teach wherein the html instruction is an italics tag. However, WebBoard taught an html instruction (html tag, paragraph 5). For motivation for combination see claim 1, above. "Official notice" is taken that an italics tag is a well known html instruction. Therefore, an italics tag is an equivalent substitution.

14. Claims 20-21 are rejected on the same rationale as claims 4 and 3, respectively.

15. As to claim 29, Shapiro taught a communication client, comprising:

a computer (end user workstation or expert workstation, col. 16, lines 1-7) for:

performing the method of previously rejected claim 1. Therefore, claim 29 is also rejected on the same rationale as claim 1, above.

16. Claim 30 is rejected on the same rationale as claim 2, above.

17. As to dependent claim 31, Walker taught wherein the real time communications protocol connection is a real time chat communications protocol connection (a synchronous communication channel to be used for real time text messaging, col. 27, lines 16-19).

Art Unit: 2758

18. As to dependent claim 32, Walker taught wherein the real time communications protocol connection is a real time continuously open bi-directional communications protocol connection (a synchronous communication channel which is used to exchange real time text messages between users, col. 27, lines 16-19).

19. As to claim 46, Walker taught a computer program product (col. 13, lines 10-13, col. 13, lines 37-39, col. 16, lines 45-48), comprising:

a computer application processable by a computer (end user interface 400, expert interface 600 and central controller 200) for causing the computer to perform the method of previously rejected claim 1 and an apparatus from which the computer application is accessible by the computer (col. 15, lines 21-23, col. 16, lines 1-7). Therefore, claim 46 is also rejected on the same rationale as claim 1, above.

20. Claims 47-49 are rejected on the same rationale as claims 2, 31-32, respectively.

21. As to claim 56, a computer program product (col. 13, lines 10-13, col. 13, lines 37-39, col. 16, lines 45-48), comprising:

a computer application processable by a computer (end user interface 400, expert interface 600 and central controller 200) for causing the computer to perform the method of previously rejected claim 14 and an apparatus from the computer application is accessible by the computer (col. 15, lines 21-23, col. 16, lines 1-7). Therefore, claim 56 is also rejected on the same rationale as claim 14, above.

22. Claims 57-61 are rejected on the same rationale as claims 15-19, respectively.

Art Unit: 2758

23. As to dependent claim 62, Walker taught wherein the real time communications protocol connection is a real time chat communications protocol connection (a synchronous communication channel to be used for real time text messaging, col. 27, lines 16-19).

24. As to dependent claim 63, Walker taught wherein the real time communications protocol connection is a real time continuously open bi-directional communications protocol connection (a synchronous communication channel which is used to exchange real time text messages between users, col. 27, lines 16-19).

25. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and WebBoard as applied to 16, above, and further in view of Reviews, Eudora Pro 3.0 (hereafter referred to as Eudora).

26. As to dependent claim 17, Walker does not specifically teach wherein the hyperlink instruction being associated with a URL and passing the URL to a Web browser. However, Eudora Pro taught wherein the hyperlink instruction being associated with a URL and passing the URL to a Web browser (Eudora Pro automatically displays URLs in colors and underlines, paragraph 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made that substituting Eudora Pro's automatic recognition of markup language instruction for Walker's messaging system would have been an equivalent substitution because Walker discloses Eudora Pro as preferred software package. The motivation for combination would have been

Art Unit: 2758

because Eudora Pro is an improved and powerful message management software with numerous features which are standard for Internet email software packages (Eudora Pro, paragraph 1).

27. Claims 5-9, 22-28, 33-45, 50-55 and 64-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of WebBoard and further in view of Eudora Pro.

28. As to claim 5, Walker taught a method for real time network communication (a method for real time synchronous communications), comprising:

forming a real time communications protocol connection over a network communications connection (forming a synchronous communication channel for real time text messaging over the network connections, col. 26, lines 45-46);

receiving a first message on the real time communications protocol connection (expert receives a message from the end user, col. 26, lines 58-67);

parsing and displaying the first message using Eudora Pro (col. 16, lines 45-52, col. 18, lines 47-56). Walker does not specifically teach text embedded in the message is a hyperlink instruction. However, WebBoard taught embedding a hyperlink instruction in a message. For motivation for combination see claim 1, above.

Walker does not specifically teach parsing the first message to identify a hyperlink instruction included therein and displaying the first message in accordance with the hyperlink instruction included therein. However, Eudora Pro taught parsing a message to identify a

Art Unit: 2758

hyperlink instruction included therein (Eudora Pro automatically recognizes URLs, paragraph 4);
and

displaying the first message in accordance with the hyperlink instruction included therein (Eudora Pro automatically displays URLs in colors and underlines, paragraph 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Eudora Pro's automatic recognition of markup language instruction in Walker's messaging system would have been an obvious variation because Walker discloses Eudora Pro as preferred software package of his invention. The motivation for combination would have been because Eudora Pro is a powerful message management software with numerous features which are the standard for Internet messaging software packages (Eudora Pro, paragraph 1).

29. As to dependent claim 6, Walker taught comprising:

embedding text in a second message (end user composing another message, col. 27, lines 1-2);

sending the second message on the real time communications protocol connection (sending message by synchronous communication protocol for real time text, col. 26, lines 58-61, col. 27, lines 48-51).

Walker does not specifically teach the embedded text is a hyperlink instruction. However, WebBoard taught embedding a hyperlink instruction in a message. For motivation for combination see claim 1, above.

Art Unit: 2758

30. As to dependent claim 7, Walker taught wherein the receiving comprises receiving the first message on a real time communication protocol connection (expert receives a message, col. 26, lines 58-67).

Walker does not specifically teach a hyperlink instruction being associated with a document address. However, WebBoard taught wherein the hyperlink instruction is associated with a document address (link to other Web site, paragraph 5). For motivation for combination see claim 1, above.

Walker does not specifically teach passing the document address to a document acquisition apparatus. However, Eudora Pro taught passing the document address to a document acquisition apparatus (command-clicking URLs, paragraph 4). For motivation for combination see claim 5, above.

31. As to dependent claim 8, Walker taught wherein:

the forming comprises forming a real time chat communications protocol connection (opening a synchronous communication channel to be used for real time text messaging, col. 27, lines 16-19); and

the receiving comprises receiving the first message on the real time chat communications protocol connection (receiving a real time text message, col. 26, lines 39-44).

32. As to dependent claim 9, Walker taught wherein:

Art Unit: 2758

the forming comprises forming a real time continuously open bi-directional communications protocol connection (opening a synchronous communication channel which is used to exchange messages between users, col. 27, lines 16-19); and

the receiving comprises receiving the first message on the real time continuously open bi-directional communications protocol connection (receiving message in real time across synchronous communication channel, col. 26, lines 39-44).

33. Claim 22 is rejected on the same rationale as claim 5 further emphasizing a hyperlink instruction is a markup language instruction.

34. Claims 23-24, 27 and 28 are rejected on the same rationale as claims 5, 7-9, respectively. With the understanding that a hyperlink instruction is equivalent to a URL.

35. As to dependent claim 25, Walker does not specifically teach wherein the html instruction is a bold tag. However, WebBoard taught an html instruction (html tag, paragraph 5). For motivation for combination see claim 1, above. "Official notice" is taken that a bold tag is a well known html instruction. Therefore, a bold tag would have been an equivalent substitution.

36. As to dependent claim 26, Walker does not specifically teach wherein the html instruction is an italics tag. However, WebBoard taught an html instruction (html tag, paragraph 5). For motivation for combination see claim 1, above. "Official notice" is taken that an italics tag is a well known html instruction. Therefore, an italics tag is an equivalent substitution.

37. As to claim 33, Walker taught a communication client comprising:

a computer (end user workstation or expert workstation, col. 16, lines 1-7) for:

Art Unit: 2758

performing the method of previously rejected claim 5. Therefore, claim 33 is also rejected on the same rationale as claim 5, above.

38. Claims 34-36 are rejected on the same rationale as previously rejected claims 5-7, respectively.

39. As to dependent claim 37, Walker taught wherein the real time communications protocol connection is a real time chat communications protocol connection (a synchronous communication channel to be used for real time text messaging, col. 27, lines 16-19).

40. As to dependent claim 38, Walker taught wherein the real time communications protocol connection is a real time continuously open bi-directional communications protocol connection (a synchronous communication channel which is used to exchange real time text messages between users, col. 27, lines 16-19).

41. As to claim 39, Shapiro taught a communication server (central controller 200, col. 13, lines 35-39), comprising:

a computer (central computer 200):

forming a communications protocol connection over a network communications connections (forming a synchronous communication channel over the network connection, col. 26, lines 45-46); and

receiving a message on the communications protocol connection (expert receives a message from the end user, col. 26, lines 58-67). Walker does not specifically teach wherein the message includes a markup language instruction. However, WebBoard taught wherein the

Art Unit: 2758

message includes a markup language instruction (html tag, paragraph 5). For motivation for combination see claim 1, above.

42. Claim 40 is rejected on the same rationale as claim 34, above.

43. As to dependent claim 41, Walker taught wherein the computer is for receiving the message from a first communication client (col. 18, lines 31-32); and

send the message on the real time communications protocol connection to a second communication client (col. 21, lines 12-16, col. 26, lines 45-49).

44. As to dependent claim 42, Walker taught wherein the message is a first message (end user message, col. 16, lines 56-57), and

wherein the computer is for receiving a second message on the real time communications protocol connection (central controller receives a response from expert, col. 16, lines 58-59).

Walker does not specifically teach a first message includes a first markup language instruction and a second message includes a second markup language instruction. However, WebBoard taught incorporating a markup language instruction in any message (paragraph 5). For motivation for combination see claim 1, above.

45. Claims 43, 44-45 are rejected on the same rationale as claims 36, 37-38, respectively.

46. As to claim 50, a computer program product (col. 13, lines 10-13, col. 13, lines 37-39, col. 16, lines 45-48) comprising:

a computer application (end user interface 400, expert interface 600 and central controller 200) processable by a computer for causing the computer to perform the method of previously

Art Unit: 2758

rejected claim 33 and an apparatus from which the computer application is accessible by computer (col. 15, lines 21-23, col. 16, lines 1-7). Where a markup language instruction is substituted for the hyperlink instruction of claim 33. Therefore, claim 50 is rejected on the same rationale as claim 33, above.

47. Claims 51-55 are rejected on the same rationale as previously rejected claim 34-38, respectively.

48. As to claim 64, Walker taught a computer program product (col. 13, lines 10-13, col. 13, lines 37-39, col. 16, lines 45-48) comprising:

a computer application processable by a computer for causing the computer to perform the functions of previously rejected claim 22 (end user interface 400, expert interface 600 and central controller 200) and an apparatus from which the computer application is accessible by computer (col. 15, lines 21-23, col. 16, lines 1-7).

49. Claims 65-68 are rejected on the same rationale as previously rejected claims 23-26, respectively.

50. As to dependent claim 69, Walker taught wherein the real time communications protocol connection is a real time chat communications protocol connection (a synchronous communication channel to be used for real time text messaging, col. 27, lines 16-19).

51. As to dependent claim 70, Walker taught wherein the real time communications protocol connection is a real time continuously open bi-directional communications protocol connection (a

Art Unit: 2758

synchronous communication channel which is used to exchange real time text messages between users, col. 27, lines 16-19).

52. Claims 10, 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and WebBoard and further in view of Amstein et al., U.S. Patent No. 5,793,966 (hereafter referred to as Amstein).

53. As to claim 10, Walker taught a method for real time network communication (a method for real time synchronous communications), the method comprising:

receiving a message including text from the host through at least one of the real time communications protocol connections (expert receives a message from the end user, col. 26, lines 58-67);

parsing and displaying the first message at the client using Eudora Pro (col. 16, lines 45-52, col. 18, lines 47-56). Walker does not specifically teach text in the message is a hyperlink instruction. However, WebBoard taught embedding a hyperlink instruction in a message. For motivation for combination see claim 1, above.

Walker does not specifically teach displaying the message in the client sent the message by the host in accordance with the hyperlink instruction included therein. However, Eudora Pro taught displaying the message in the client sent the message by the host in accordance with the hyperlink instruction included therein (Eudora Pro automatically displays URLs in colors and underlines, paragraph 4). For motivation for combination see claim 5, above.

Art Unit: 2758

Walker does not specifically teach wherein the network connections are TCP/IP connections formed between a plurality of clients and a host, and respective real time communications protocol connections formed over the TCP/IP connections. However, Walker taught the Internet as a network connecting the end user to the expert through a central controller (col. 15, lines 27-31).

Accordingly, Amstein taught that the Internet includes TCP/IP connections formed between a plurality of clients and a host (col. 11, 48-50) and that a communications protocol connection (HTTP) is formed over the TCP/IP connections (col.12, lines 19-21). It would have been obvious to one of ordinary skill in the art at the time the invention was made that substituting Amstein's communication protocol connections over TCP/IP for Walker's synchronous communications channel would have increased system effectiveness because the TCP/IP suite is the most widely used protocol suite for the Internet. The motivation would have been because communication protocols, such as HTTP, formed over TCP/IP connections are a standard in the Internet.

54. As to dependent claim 12, Walker wherein the real time communications protocol connections are real time chat communications protocol connections (opening a synchronous communication channel to be used for real time text messaging, col. 27, lines 16-19), and

wherein the receiving comprises receiving the first message on the real time chat communications protocol connection (receiving a real time text message, col. 26, lines 39-44).

Art Unit: 2758

55. As to dependent claim 13, Walker taught wherein the real time communications protocol connections are real time continuously open bi-directional communications protocol connection (opening a synchronous communication channel which is used to exchange messages between users, col. 27, lines 16-19), and

the receiving comprises receiving the first message on the real time continuously open bi-directional communications protocol connection (receiving a real time text message, col. 26, lines 39-44).

56. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and WebBoard and Amstein as applied to claim 10 above, and further in view of Eudora Pro.

57. As to dependent claim 11, Walker does not specifically teach the message including a hyperlink instruction associated with a document address. However, WebBoard taught the message including a hyperlink instruction associated with a document address (link to other Web sites, paragraph 5). For motivation for combination see claim 1, above.

Walker does not specifically teach passing a document address to a document acquisition apparatus. However, Eudora Pro taught passing a document address to a document acquisition apparatus. (command-clicking URLs, paragraph 4). For motivation for combination see claim 7 above.

Art Unit: 2758

Conclusion

58. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Trudeau, U.S. Patent No. 5,987,401: taught a real-time text-based messaging system through an on-line service provider using IRC (internet relay chat protocol).

Response to Arguments

b. Applicant's arguments filed on May 10, 2000 have been fully considered but they are not persuasive.

59. Applicant argues – “There is no motivation, teaching or suggestion in Walker to modify the system to send a message having a markup language instruction embedded therein.” “There is no motivation, teaching or suggestion in WebBoard to combine the disclosed system with a synchronous channel.”

a. The motivation for combination is not limited to the disclosure of the prior art cited in the rejection. The motivation for combination is dictated by one of ordinary skill in the art not the references which happen to be cited in the rejection.

b. Hoffer, U.S. Patent No. 5,799,151 (previously cited prior art) discloses the message exchanges in a real-time bulletin board system (BBS, col 2, lines 9-30). Establishing the usefulness of a synchronous channel in a bulletin board system (“bi-directional communication channels”). Thus, Hoffer provides motivation for viewing Walker’s synchronous communications

Art Unit: 2758

channel between an enduser and an expert as a real-time bulletin board system. WebBoard's enhancement would be seen an improvement to a real-time bulletin board system for the reasons given above.

60. Applicant argues – “Eudora does not contain any motivation, teaching or suggestion that it should be combined with a system for establishing a synchronous communications channel between an expert and an end user (as in Walker) or with a system for enhancing a traditional bulletin board (as in WebBoard).”

a. The email system used to implement Walker's synchronous channel connecting an enduser and an expert is not proprietary software, but Eudora Pro software (col. 18, lines 47-53). Therefore, at least there is motivation for combination of the features of Eudora's email software and Walker's synchronous channel.

61. Applicant argues – “Walker does not teach parsing a message to identify a hyperlink therein and displaying the message in accordance with the hyperlink.” “Eudora does teach or suggest that the URL's are accompanied by hyperlinks in the message.”

a. By convention when URL's embedded in a received email message are recognized by the email software they are highlighted in the message display. If a communications channel is already open, when the user clicks on the displayed URL it functions as a hyperlink. Therefore, because the Walker-WebBoard combination maintains an open communications channel the embedded URL appears is highlighted, thus the embedded URL is interpreted as a hyperlink.

Art Unit: 2758

62. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2758


63. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is (703) 305-3938. The examiner can normally be reached on Monday-Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

plw
Plw

Monday, July 17, 2000


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700